

Remarks

Status of the Claims

Claims 1, 6-8, 10, 11, and 13-53 are pending in the application. All claims stand rejected. Claims 14, 20, 21, 26, 28, 30, 33, 34, 37, 38, 40, 44, 47-49, and 51-53 are currently amended. Claims 2-5, 9, 12, 24, 25, 31, 36, 41, and 50 are canceled. Reconsideration of all pending claims herein is respectfully requested.

Claim Rejections

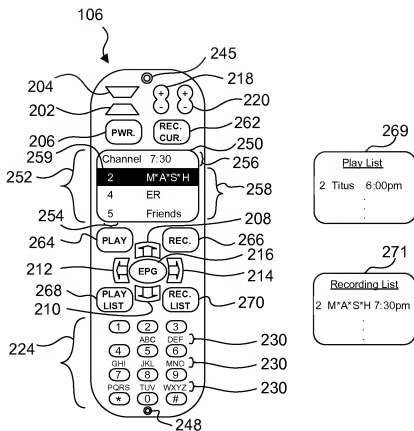
Claims 1-53 were rejected under 35 U.S.C. 103(a) as being unpatentable over Terakado et al. ("Terakado") in view of Elliott et al. ("Elliott"). This rejection is respectfully traversed.

1. The cited references do not disclose or suggest a remote control device that receives a play list from a digital video recorder.

Claim 1 recites a remote control device for a digital video recorder that comprises:

a wireless receiver for receiving a **play list from the digital video recorder**, the play list comprising television programs **previously recorded** by the digital video recorder;

FIG. 2 of the present application (reproduced below for the Examiner's convenience) illustrates three distinct types of lists that can be shown on integrated display screen 250 of the claimed remote control device, *i.e.*, an electronic program guide (EPG) 252, a play list 269, and a recording list 271.



The EPG 252 is a listing of current and/or future television programs available from a number of broadcasters. The play list 269, on the other hand, is a list of television programs previously recorded by the digital video recorder. The recording list 271 is a list of television programs scheduled to be recorded by the digital video recorder. See specification at pages 11-12.

According to the Office Action, Terakado discloses a “wireless receiver for receiving a play list from the digital video recorder, the play list comprising television programs previously recorded by the digital video recorder ... see Fig. 1 items 1, 9, 13, FIG. 2, 9.” Office Action at page 2. However, nothing in Terakado suggests a play list, much less a play list received by a remote control from a digital video recorder, as claimed. For instance, the items referred to in the Office Action are

respectively a "remote controller" (1), a "television receiver" (9), and a video tape recorder ("VTR") (13). Of these, only the VTR is capable of recording. However, anyone who has used a VTR knows that a VTR does not normally generate or display play list of recorded programs.

The Office Action's reference to FIG. 9 of Terakado is misplaced because it "shows an example of an EPG to be displayed on the LCD if [sic] as a result of the above operation" (col. 9, lines 34-35) (emphasis added). An EPG is not a "play list" of television programs previously recorded by a DVR, as claimed. Rather, it is a list of upcoming programs. Indeed, Terakado's EPG in FIG. 9 is clearly labeled "FUTURE BROADCAST PROGRAMS."

Accordingly, the Office Action's assertion that Terakado discloses a "wireless receiver for receiving a play list from the digital video recorder, the play list comprising television programs previously recorded by the digital video recorder" is simply not correct. At best, Terakado discloses a remote control that is capable of receiving and displaying an electronic program guide (EPG).

Moreover, Terakado's remote control does not even receive the future EPG data from a recording device, such as the VTR. Rather, according to Terakado, "[r]adio waves transmitted from the antenna of a broadcasting station are received by the antenna of a television receiver. The television receiver extracts an EPG from the received radio waves and transmits it to a remote controller.... The remote controller displays the received EPG on an LCD If some program is selected ..., the remote controller transmits a control command for a recording reservation to a video tape recorder." Abstract (emphasis added).

Thus, Terakado's remote control merely receives EPG data from a television set. This is not at all similar to the claimed remote control that receives a play list, comprising a list of previously recorded programs, from a digital video recorder. Not only the type of data being transmitted is different, but also the origin of the transmission is not the same:

	<u>Claimed Invention</u>	<u>Terakado</u>
<u>What is transmitted:</u>	Play list comprising programs <i>previously recorded</i> by DVR	EPG comprising "Future Broadcast Programs" (See FIG. 9)
<u>Origin of transmission:</u>	DVR (digital video recorder)	Television receiver (television set)

The only communication discussed in Terakado between the remote control and the VTR is unidirectional. The remote sends channel, date, and time information to the VTR to schedule a recording. Col. 10, lines 42-50. By contrast, all of the independent claims, including claim 1, recite transmitting information from the recording device (DVR) to the remote control for display on the integrated LCD.

In fact, Terakado teaches the exact opposite of transmitting program data from the VTR to the remote control. When a user makes a selection of a program displayed by the remote control, the remote control sends schedule information (date, time, channel) to the VTR to schedule a recording. If Terakado's VTR already had the schedule information for a program (in order to be able to transmit it to the remote control, as claimed), there would be no need to transmit the date, time, and channel

of a selection to the VTR. This would be completely redundant. Thus, Terakado teaches away from the claimed invention.

Furthermore, unlike the claimed invention, Terakado requires a special television receiver. Conventionally, TVs are simply monitors. They have nothing to do with recording programs. Terakado requires intelligence in the TV to extract EPG data from the radio waves and transmit the EPG to the remote control. By contrast, the claimed invention transmits schedule information and play lists from the DVR to the remote control.

The addition of Elliott does not supply the missing element of transmitting a play list from a recording device to a remote control. While it is true that Elliott discloses a standard digital video recorder (DVR), Elliott does not transmit any information (let alone the claimed play list) from the DVR to a remote control. While standard DVRs include something like the claimed play lists, they are universally displayed on the main television screen, contrary to the principles of the claimed invention, since they interfere with television viewing.

Accordingly, the Office Action is apparently relying on impermissible hindsight reconstruction for at least two claimed elements that are completely absent in the prior art of record:

- (1) transmitting a play list comprising previously recorded programs to a remote control; and
- (2) transmitting a play list from a digital video recorder to the remote control.

Neither of these limitations are disclosed or suggested in the prior art, and any attempt to read them into the references requires the use of the present application as a roadmap.

To further illustrate this point, a side-by-side comparison of Terakado and Elliott is instructive.

Terakado

- No play lists on remote or TV
- Remote receives EPG from TV, not recording device
- **VTR does not send data to remote control** (no disclosure)

Elliott

- Play list on main TV screen only (interferes with TV viewing)
- No transmissions from DVR to remote

No conceivable combination of these references can produce the claimed limitations of “a wireless receiver [in a remote control] for receiving a **play list from the digital video recorder**, the play list comprising television programs **previously recorded** by the digital video recorder,” as claimed.

A person of ordinary skill in the art would not be able to combine Elliott with Terakado without hindsight reconstruction based on the Applicants' own teachings. To display a play list on a remote control would require communication of the play list from the recording device to the remote control. Since neither of the references teach this, the Applicants respectfully submit that the Office Action is impermissibly relying on the Applicants' own teachings. See *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999) (holding the Board impermissibly used hindsight in determining obviousness).

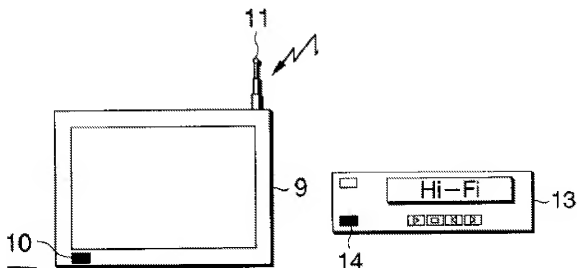
A rejection based on prior art – whether grounded in anticipation or obviousness – must account for each and every claim limitation. *Celeritas Techs. Inc. v. Rockwell Int'l Corp.*, 150 F.3d 1354, 1360, 47 U.S.P.Q.2d 1516, 1522 (Fed. Cir. 1998) (anticipation); *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q.2d 494, 496 (CCPA 1970) (obviousness); MPEP § 2143.03 (“To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.”) (emphasis added). In this case, the cited references are clearly deficient in that (1) there is no teaching or suggestion of displaying a play list on an integrated display of a remote control, and (2) there is no teaching or suggestion of a remote control wirelessly receiving a play list from a DVR or other recording device. Applicants respectfully request that the obviousness rejection be withdrawn. All other independent claims have been amended to include similar limitations and are likewise believed to be allowable for at least the same reasons.

2. The cited references do not disclose or suggest a digital video recorder comprising a wireless transmitter for transmitting a play list (or any other list of television programs) to a remote control device.

Independent claim 14 recites “a digital video recorder comprising: a wireless transmitter for transmitting a play list comprising indications of television programs previously recorded by the digital video recorder to a remote control device.” The Office Action points to items 10 and 14 of Figs. 1, 5, and 6 of Terakado for this limitation.

A closer look at the references, however, reveals that the combination is utterly deficient with respect to a recording device including a transmitter for

transmitting a play list (or another list of television programs) to a remote control. Item 10 of Terakado is not a component of the recording device (VTR 13), but, rather, of the television receiver 9. A person of ordinary skill in the art confuse Terakado's television display (illustrated below) as a digital video recorder. There is simply no disclosed mechanism for recording anything.



Item 14 of Terakado's VTR 13 is merely a infrared transceiver, which includes combined reception/transmission capabilities for manufacturing convenience. The reference is absolutely silent about the VTR's transceiver 14 being used for transmission of anything. There is no hint or suggest that the VTR's transceiver 14 could be used for transmitting a list of television programs to the remote control, let alone a play list. A person of ordinary skill in the art would not normally expect a video tape recorder to transmit anything to a remote control, much less a list of television programs. To make the statement that Terakado teaches "a digital video recorder comprising: a wireless transmitter for transmitting a play list comprising indications of television programs previously recorded by the digital video recorder to

a remote control device” requires significant reliance on hindsight using Applicant’s own teachings as a roadmap.

Independent claims 33, 40, 52, and 53 also recite that the digital video recorder transmits a “play list” to the remote control. For example, independent claim 33 recites a method “in a remote control device” including the step of “receiving a list of television programs from the digital video recorder.” As argued above, there is no teaching or suggestion of transmitting a list of television programs (either representing live broadcasts or previously recorded programs) from the DVR (or VTR) to the remote control, much less a play list.

Conclusion

In view of the foregoing, the applicants respectfully submit that all pending claims, as amended, are patentably distinct over the cited references, alone or in combination. Early allowance of all pending claims herein is respectfully requested.

Respectfully submitted,

Digeo, Inc.

By /Kory D. Christensen/
Kory D. Christensen
Registration No. 43,548

STOEL RIVES LLP
One Utah Center Suite 1100
201 S Main Street
Salt Lake City, UT 84111-4904
Telephone: (801) 328-3131
Facsimile: (801) 578-6999